**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|---|---|---|
| In re application of: | ) | Confirmation No.: 3752 |
| | ) | |
| Kazuo YAMASHITA et al. | ) | Art Unit: 1793 |
| | ) | |
| Serial No: 10/556,934 | ) | Examiner: Colin W. SLIFKA |
| | ) | |
| National Phase Filed: November 16, 2005 | ) | |

For: PRECIPITATED CALCIUM CARBONATE, METHOD FOR PRODUCING THE SAME AND FILLER FOR LOADING PAPER USING THE SAME

STATEMENT OF THE SUBSTANCE OF INTERVIEW OF SEPTEMBER 22, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is in response to the "Interview Summary" dated September 22, 2010

A personal interview with the Examiner Colin Slifka and Examiner Curtis Mayes was conducted on September 22, 2010.

1. Brief Description of any exhibit shown or demonstration conducted

See the attached proposed response transmitted to the Examiner for review on September 21, 2010.

2. Identification of claims discussed

Claims 1 and 2

3. Identification of specific prior art discussed

Kurata et al and Nishijima et al

4. Identification of the principal proposed amendments of a substantive nature

See the attached proposed response of September 21, 2010.

5. A brief identification of the general thrust of the principal arguments presented to the Examiner

See the attached proposed response of September 21, 2010, the response as filed September 27, 2010 and the Examiner's "Interview Summary."

6. A general indication of any other pertinent matters discussed

None

7. The general results or outcome of the interview.

See the Interview Summary Form.

Respectfully submitted,
Bacon & Thomas, PLLC

George A. Loud
Reg. No. 25,814

Dated: October 1, 2010

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# *FACSIMILE COMMUNICATION*

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*Re:* USSN 10/556,934

*From:* George Loud, Bacon & Thomas, PLLC
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*Date:* September 21, 2010



**7** Pages Sent Including This Sheet.

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## *Message:*

Mr. Slifka,
I am herewith transmitting a proposed response for your review in preparation for our interview scheduled for 2:00 PM on Wednesday, September 22nd.
George Loud

# PROPOSED RESPONSE - DO NOT ENTER

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| Kazuo YAMASHITA et al. | ) | Art Unit: 1793 |
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| Serial No: 10/556,934 | ) | Examiner: Micali, Joseph |
| | ) | |
| National Phase Filed: November 16, 2005 | ) | |

For: PRECIPITATED CALCIUM CARBONATE, METHOD FOR PRODUCING THE SAME AND FILLER FOR LOADING PAPER USING THE SAME

RESPONSE TO FINAL ACTION UNDER 37 CFR 1.116

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the office action of May 25, 2010, please amend the captioned application as follows.

IN THE CLAIMS:

1. (Currently amended) Precipitated calcium carbonate having a secondary particle diameter of 1 to 10 μm, each secondary particle being in the form ~~consisting~~ of an aggregate of flocculated primary particles, the primary particles being ~~of~~ spindle-shaped calcium carbonate particles, each having a long diameter of 0.5 to 3.0 μm, a short diameter of 0.1 to 1.0 μm and an aspect ratio of 3 or more, wherein the BET specific surface area is in the range of 8 to 20 $m^2/g$, and the pore volume is in the range of 1.5 to 3.5 $cm^3/g$.

2. (Previously presented) A method for producing the precipitated calcium carbonate as defined in claim 1, wherein carbon dioxide or carbon dioxide containing gas is blown into a calcium hydroxide slurry having a calcium hydroxide concentration of 100 to 400 g/L obtained by wet slaking calcined lime whose 4 N hydrochloric acid activity (value at 3 minutes) is adjusted to 150 to 400 mL for reaction until the carbonation rate is 50 to 85% by volume of the calcium hydroxide slurry is added, and carbon dioxide or carbon dioxide containing gas is then introduced to terminate the reaction.

3. (Previously presented) Precipitated calcium carbonate manufactured by the producing method of Claim 2.

4. (Previously presented) The precipitated calcium carbonate according to Claim 3, wherein the BET specific surface area is in the range of 8 to 20 $m^2/g$, and the pore volume is in the range of 1.5 to 3.5 $cm^3/g$.

5. (Previously presented) A filler for loading paper, which contains the precipitated calcium carbonate according to Claim 1.

6. (Original) A loaded paper, which contains the filler for loading paper according to Claim 5.

7. (Original) A loaded paper, which contains 5 to 50 parts by weight of the filler for loading paper according to Claim 5 based on pulp material as 100 parts by weight.

8. (Previously presented) A filler for loading paper, which contains the precipitated calcium carbonate according to Claim 3.

9. (Previously presented) A filler for loading paper, which contains the precipitated calcium carbonate according to Claim 4.

REMARKS

Regarding the term "aggregate" which would be added to claim 1 by the proposed amendment, see, for example, page 4, lines 7-11, and the abstract of the English translation of applicants' specification. The amendment is offered as a clarification. Note that the language of claim 1, as presented in applicants' previous response, defined the primary particles as "flocculated" which is treated as a synonym for "aggregated" in one definition to be found in standard dictionaries.

The rejection of claims 1 and 3-9 for obviousness over Kurata et al (JP 2000-212892) in view of Nishijima et al (JP 10-310996) is respectfully traversed. Neither Kurata et al nor Nishijima et al disclose or suggest a calcium carbonate in the form of aggregates (secondary particles), each aggregate consisting of spindle-shaped **primary** particles. At bottom of page 3 of the final action the Examiner correctly characterizes Kurata et al as disclosing "such a coating composition is composed of a spindle-shaped precipitated calcium carbonate .... in a **secondary** particle shape." [Emphasis of the undersigned]. In [0017] Kurata et al teach "That **aggregated particle shape is spindle-shaped** has the big feature ... ." Also see [0011], [0012] and [0025]. Applicants are not claiming a calcium carbonate in the form of spindle-shaped aggregates (secondary particles); rather, applicants here claim a calcium carbonate product in the form of aggregates, each aggregate consisting of **primary** particles which are spindle-shaped and have the other characteristics recited by applicants' claims, and a method of producing same. Applicants' aggregates (secondary particles) are not themselves spindle-shaped, as they have verified by SEM.

The secondary reference, Nishijima, is not cited for any disclosure of a spindle-shaped particle and no combination of Kurata et al and Nishijima would lead to aggregates of primary particles, wherein the primary particles forming the aggregates are themselves spindle-shaped.

Further, even if aggregates of spindle-shaped primary particles were disclosed by Kurata et al, it would not have been obvious from the teachings of Nishijima et al to provide those hypothetical primary particles with an aspect ratio of 3.0 or more. Nishijima et al teach only how to produce such an aspect ratio in a

"needle-like or prism-like precipitated calcium carbonate," quoting from the English language abstract, not in a differently shaped particle.

At page 6 of the final action the Examiner asserted "that features upon which the applicant relies (i.e., aggregates) are not recited in the rejected claims." In making the quoted statement the Examiner either overlooked or misunderstood "flocculated" in applicants' claim 1. In any event, an amendment is proposed to provide any needed clarification.

At page 6 of the final action the Examiner also states:

> "Applicant's argumentation on the production of the calcium carbonate particles is not persuasive, as the instantly claimed invention is drawn to the product, not the process of making."

The comment quoted immediately above apparently has reference the argument in applicants' previous response to the effect that the reference teachings "could not properly be characterized as enabling for the product claimed here." As noted in applicants' previous response, Kurata et al do not teach how to make any calcium carbonate particulate product. In [0021] Kurata et al identify a commercial source for their spindle-shaped secondary particles (aggregates). Even if commercial availability of the spindle-shaped aggregates could be relied upon as indicating that a method for forming spindle-shaped aggregates is known in the art, it would not logically follow that a method for making spindle-shaped primary particles (that make up an aggregate) is also known. Unless one skilled in the art would know how to make (a method) the product claimed here, the references cannot properly be characterized as enabling for the claimed product and, for lack of enablement, do not support a *prima facie* case for obviousness of the product (or a process). *In re Hoeksema*, 158 USPQ 596 (CCPA 1968).

Regarding potential rejoinder of claim 2 and the Examiner's remarks in the first paragraph of section 6, at page 5 of the final action, MPEP 821.04(b) provides for rejoinder of a process claim upon allowance of a product claim, provided the process claim includes all limitations of the allowable product claim. In belief that claim 1 was in condition for allowance, in applicants' previous response, process claim 2 was amended to depend from claim 1 and thereby limited by incorporation of all limitations of claim 1.

In conclusion it is respectfully requested that the Examiner reconsider and withdraw the rejection of record and rejoin claim 2.

Respectfully submitted,
BACON & THOMAS, PLLC

Date: September 22, 2010

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